

REMARKS

This application is a continuation of parent application 08/973,019, which is currently under appeal in the United States Patent and Trademark Office.

The purpose of this application and accompanying preliminary amendment is to place the claims in allowable form.

Applicant reserves the right to pursue the rejected claims now under appeal.

Applicant wishes to thank the Examiners Mullins and Enad for the opportunity to discuss the application during an office interview conducting May 14, 2003.

During the course of the interview, Applicant's proposed to amend the claims in order to recite that the high voltage winding of the rotating electric machine is operable above 36 kV up to a system voltage and is in the form of a flexible cable.

Support for the teaching set forth in the specification at various locations set forth hereinafter. For example, in the Background of the Invention, at page 5, line 34 - page 6, line 6, it is stated that if it were to be possible to manufacture machines for considerably higher voltages of the power network it would be possible to eliminate the intermediate step up transformer which is normally required. Thus resulting in considerable savings. On page 6 lines 8-14 it is stated that the maximum voltage of conventional rotating machines is 25-30 kV. On page 9 lines 12-21, it is stated that a few generators were produced with voltages up to 36 kV.

In the Summary of the Invention it is stated that it is an object of the invention to obtain a rotating machine with a high voltage such that the step up transformer may be omitted, that is machines with a considerably higher voltage than the state of the art.

In the Description of the Invention at page 14 an example is given of an arrangement of a conventional synchronous compensator operable above 20 kV.

It is noted that the rotating machine may be connected to one or more system voltage levels while keeping the electric field outside the machine to a minimum (page 14 lines 29-32.).

Besides these indications, page 17 of the specification sums up the intended overall range of “high voltage” by noting that “[h]igh voltage in this respect voltages exceeding 10kV and up to the voltage levels which occur for power networks.”

Accordingly, there can be no doubt that the specification disclosure indicates that “high voltage” means a range of 10kV up to the voltage levels which occur for power networks to those of ordinary skill in the art, where voltages of 25-30kV, 20kV, and 36kV were all noted as separate levels in that range. The claims are now all limited to a range of “above 36kV through a system voltage of a power network” that clearly lies within the above-noted disclosed range. See *In re Wertheim*, 191 USPQ 90, (CCPA 1976) which found that specific suggestions of particular values of 36% and 50% along with an overall range of 25-60% were sufficient to support a subsequent claim with a range of 35-60% that was not literally set forth in the original specification. In this regard, the court emphasized that literal support is not required to indicate what the artisan would interpret to be clearly part of the originally described invention.

In the Decision on the appeal of the parent application, the Board erroneously indicated that the nexus between the range set forth in the declaration evidence of record did not have a nexus with the claim because of claim scope being broader. Accordingly, this declaration evidence of record was considered by the Board to not be sufficient to overcome the rejection. However, it is clear from page 14 of the Decision that the Board has held that if “the claims were limited to voltages over 30 kV, for example, then evidence of commercial success would be of greater probative value in determining the obviousness of the claimed invention.” Thus, as all of the claims require “an inclusive range of above 36 kV through a

system voltage of a power network,” which is a range even narrower than the range suggested by the Board, the evidence of record can no longer be ignored based upon the erroneous nexus reasoning present in the Board’s decision.

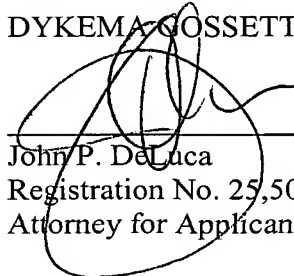
The flexible cable is described at page 16, lines 33-35. Accordingly, it is believed that this claimed feature is supported as well.

Allowance of the claims is earnestly solicited.

If filing this paper or any accompanying papers necessitates additional fees not otherwise provided for, the undersigned authorizes the Commissioner to deduct such additional fees from Deposit Account No. 04-2223.

Respectfully submitted,

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